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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------------------|-----------------------------|
| 10/519,538 | 12/28/2004 | Yoshiko Hino | 47233-0049-00-US (220489) | 2594 |
| 55694 7590 08/03/2010 DRINKER BIDDLE & REATH (DC) 1500 K STREET, N.W. SUITE 1100 WASHINGTON, DC 20005-1209 | | | EXAMINER PADEN, CAROLYN A | |
| | | | ART UNIT 1781 | PAPER NUMBER |
| | | | NOTIFICATION DATE 08/03/2010 | DELIVERY MODE ELECTRONIC |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

DBRIPDocket@dbr.com
penelope.mongelluzzo@dbr.com

| | | | |
|------------------------------|--------------------------------------|------------------------------------|--|
| Office Action Summary | Application No. 10/519,538 | Applicant(s) HINO ET AL. | |
| | Examiner Carolyn A. Paden | Art Unit 1781 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 June 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 and 6-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 6-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>11-20-09</u> | 6) <input type="checkbox"/> Other: _____ |

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-4 and 6-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kanebo (JP 06-292544) in view of Rusoff (2,957,769) for reasons of record.

Kanebo discloses the preparation of a beverage containing fats and oils that is filled into a hermetically sealed container. On page 19 cacao extract is prepared by mixing cacao nibs in warm water and then separating the solid from the liquid with a paper filter to obtain cacao extract. Extracted solutions of cocoa beans are mixed with water and an emulsifying agent and the mixture is heated to less than 85C and then homogenized (abstract and Table 1 and page 19 of translation). Milk is included in the beverage (see Key for Table 1 on page 19). The homogenization step is said to create a stable beverage solution. The claims appear to differ from Kanebo in the use of a centrifuge for removing insoluble solids from the cocoa extract. Rusoff teaches extracting cocoa beans with hot water (see example 1 and column 3, lines 70-75). When

fine particle sizes of the cacao beans are used, Rusoff suggests there is a need for filtering the extract (column 4, lines 39-47). The use of a centrifuge to filter the cocoa extract is described at column 4, lines 66-70. The final cocoa extract is said to contain 2-65 solids (column 4, lines 72-74). It would have been obvious to one of ordinary skill in the art to use the centrifuge of Rusoff to filter the extract of Kanebo to create a cacao extract containing smaller particles in it. It is appreciated that the temperature of centrifugation is not mentioned but one of ordinary skill in the art, who desired a high fat chocolate beverage, would be expected to centrifuge the cocoa above the melting point of the cocoa fat so that the fat does not solidify and be removed from the extract during processing. Kanebo discloses that his beverage may have a fat content of 0.5% to 1% or more at page 10, paragraph 0012.

Applicant has amended the claims to include a homogenization pressure and a fat content for the drink. Kanebo discloses that his beverage may have a fat content of 0.5% to 1% or more at page 10, paragraph 0012. With regard to the homogenization pressure, Kanebo uses a higher pressure of 500 kg/cm in paragraph 0022 on page 14. But at page 7 in paragraph 0006, lower pressures of 200 to 250 kg/cm are

contemplated for beverages whose fat content does not exceed 1%.

Considering that the fat content in the process of the claims includes 1%, it would have been obvious to utilize lower homogenization pressures in Kanebo to prepare the chocolate drink of the claims.

Applicant argues that the references only mention the use of a centrifuge but centrifugation is suggested as an alternative and equivalent conventional means of filtration. Applicant argues that a disk centrifuge is not mentioned in the references. This has been considered but is not persuasive. It is appreciated that a disk centrifuge is not mentioned but Rusoff teaches centrifugation as an alternative to filtration. The selection of a disk centrifuge would be expected to also act to filter the cocoa ingredients as a centrifuge. The disk centrifuge is seen to be an apparatus limitation, carrying no weight in process claims. No unobvious or unexpected result is seen from the selection of a disk centrifuge in the process of separating liquid from solid cocoa ingredients. As to the recitation "for two phase liquid-solid separation", one of ordinary skill in the art would expect a centrifuge to effect two phase liquid solid separation because the centrifuge is used as an alternative to filtration.

Applicant argues that Rusoff does not disclose the fat content for the beverage of the claims. Another look at Kanebo shows that Kanebo discloses a beverage with a fat content of 0.5% to 1% or more, which appears to fall within the fat content set forth in the claims.

Applicant argues that Rusoff is directed to preparing a fat-free extract for cacao but applicants chocolate drink also has a limited amount of fat.

Applicant argues that Rusoff uses paper filters. But centrifugation is also contemplated in Rusoff as discussed above.

Applicant argues that Kanebo uses emulsifying agents and stabilizers in his process. This has been considered but is not persuasive. The claims are open to the inclusion of additional ingredients. Examiner has provided a full translation of Kanebo in order to view Kanebo as a whole.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory

period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carolyn A Paden whose telephone number is (571) 272-1403. The examiner can normally be reached on Monday to Friday from 7 am to 3:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Keith Hendricks can be reached by dialing 571-272-1401. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on

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access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Carolyn Paden/

Primary Examiner 1781